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EXAMINER

DIVINE, LUCAS

ART UNIT PAPER NUMBER

2624

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,078

Applicant(s)

STINGHAM, GARY

Examiner

Lucas Divine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 1/8/04 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

The faxed in IDS filed 1/8/04 (see PAIR for image) is not complete, and Examiner can not read what was stated on the IDS. Therefore, Examiner has not considered documents on the IDS. Examiner has considered the documents stated on the International Search Report included in the fax transmission.

There is no 1449 attached herewith due to the 1449 not being correctly transmitted for use to the Patent Office (again, see PAIR for what was received by the Office).

Drawings

2. The drawings are objected to because the buttons shown in Fig. 5 are shown on top of the message to the user. Examiner believes the message '**Any Other Languages to Translate to?**'

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should be above the buttons for the user to read. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1, 5, 8, 12, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Chong (US 5175684).

Regarding claim 1, Chong teaches **a system** (translating and printing system shown in Fig. 1) **for executing a print job of an electronic document** (a print is completed in step B or an inputted print job at step A, wherein a printer is designated as the output), **said print job containing translations in a plurality of languages of said document** (the print job contains plural languages throughout the system, original language inputted and additional languages translated to, see Figs. 1 and 2), **the system comprising:**

a translation module (the control program within the host computer 10 that controls the translation program 20 [See Fig. 1 for control and data signals from host 10 to program 20]) **of a printer driver** (Fig. 1, the software of computer system 10 that includes formatting and of print data as well as controlling of the printing processes 20, 30, and 40 drives the printing within the system) **running on a host computer** (the workstation element 10 as shown in Fig. 1 are part of a computer system; col. 5 lines 39-40 and 58-60, wherein the user can be at the particular station if desired to control the job, for example, a user uses a scanner as input in step A and must then set the languages [see Fig. 2] of output at the workstation element 10), **wherein said translation module accepts user input specifying at least one additional language into which a document of a print job is to be translated** (Fig. 2, wherein a user selects what languages that each address [other user] would like [col. 4 line 66], and it is accepted by the workstation which forwards that information to the translation program in the form of (Target L.) in Fig. 1) **and calls a translation program to perform translation of the document** (Fig. 1 shows the

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translation module 20 which acts as a translation program to translate the document into the selected languages; col. 4 lines 55-59); **and**

a printer (Fig. 1 printer [see step B]) for printing said print job including at least one hardcopy of said document translated into said additional language (the document printed is in the additional languages selected by the user [shown in Fig. 2]).

Regarding claim 5, Chong teaches that **translation program is a program residing on said host computer** (col. 6 line 30, wherein the translation module 20, which acts as a program to translate the print data, is located on the workstation computer).

Regarding claim 8, the structural elements of apparatus claim 1 perform all of the method steps of method claim 8. Method claim 8 is therefore rejected for the same reasons as stated in the rejection of apparatus claim 1.

Regarding claim 12, which depends from claim 8, the structural elements of apparatus claim 5 perform all of the method steps of method claim 12. Method claim 12 is therefore rejected for the same reasons as stated in the rejection of apparatus claim 5.

Regarding claim 15, the structural elements of apparatus claim 1 perform all of the program functions of the printer driver program of claim 15. Further, a computer system such as 10 (Fig. 1) is known in the art to have a CPU and memory to execute instructions. Claim 15 is therefore rejected for the same reasons as stated in the rejection of apparatus claim 1.

Regarding claim 18, the structural elements of apparatus claim 1 are the same or equivalent to the means of apparatus claim 18. Claim 18 is therefore rejected for the same reasons as stated in the rejection of claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 9, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong as applied to claims 1, 8, 15, and 18 above, and further in view of Neilsen (US 6639687).

Regarding claim 2, which depends from claim 1, while Chong teaches the selection of users to print for, including the languages for each user (Fig. 2), Chong does not specifically teach in the selection of how many hardcopies of each print job for each user.

Neilsen teaches selecting the number of hardcopies to print for a print job (Fig. 2).

It would have been obvious to one of ordinary skill in the art that for each translation of Chong it would be beneficial to be able to select how many copies for that language/person. The motivation for doing so would be to allow multiple people (at one address) receive multiple copies of a job. For example, if one of the users being sent to is in an office that prefers German, that person could be sent 10 copies of German translation for the whole office, and so forth. Thus, adding a number of hardcopies option to the selections of Chong Fig. 2 would have been obvious to one of ordinary skill in the art.

Regarding claim 9, which depends from claim 8, the structural elements of apparatus claim 2 perform all of the method steps of method claim 9. Method claim 9 is therefore rejected for the same reasons as stated in the rejection of apparatus claim 2.

Regarding claim 16, which depends from claim 15, the structural elements of apparatus claim 2 perform all of the program functions of the printer driver program of claim 16. Further, a computer system such as 10 (Fig. 1) is known in the art to have a CPU and memory to execute instructions. Claim 16 is therefore rejected for the same reasons as stated in the rejection of apparatus claim 2.

Regarding claim 19, which depends from claim 18, the structural elements of apparatus claim 2 are the same or equivalent to the means of apparatus claim 19. Claim 19 is therefore rejected for the same reasons as stated in the rejection of claim 2.

5. Claims 3, 4, 10, 11, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong as applied to claims 1, 8, 15, and 18 above, and further in view of Neilson and Aihara et al. (US 6592275) hereafter as Aihara.

Regarding claim 3, which depends from claim 1, while Chong teaches the selection of users to print for, including the languages for each user (Fig. 2), Chong does not specifically teach in the selection of how many hardcopies of each print job for each user or selecting a bin for each language.

Neilson teaches selecting the number of hardcopies to print for a print job (Fig. 2). It would have been obvious to one of ordinary skill in the art that for each translation of Chong it would be beneficial to be able to select how many copies for that language/person. The

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motivation for doing so would be to allow multiple people (at one address) receive multiple copies of a job. For example, if one of the users being sent to is in an office that prefers German, that person could be sent 10 copies of German translation for the whole office, and so forth. Thus, adding a number of hardcopies option to the selections of Chong Fig. 2 would have been obvious to one of ordinary skill in the art.

While the combination teaches choosing a user to translate and print for, including how many copies, the combination of Chong and Neilson do not specifically disclose selecting an output receptacle for the jobs to be output.

Aihara teaches associating a user with an output bin (Figs. 11 and 13).

It would have been obvious to one of ordinary skill in the art that if the different users selected in Fig. 2 of Chong were picking up the jobs at the local printer (suggested in Fig. 1), that it would be beneficial to have separate bins for the users. The motivation for doing so would have been to place different translations in different bins so who gets the jobs with a specific language is not mixed up. For example, in Fig. 13 of Aihara, different users are associated with bins. So User A could be associated with ADDR#1 (Chong Fig. 2) and the language could be Chinese, but both users C (ADDR#3) and E (ADDR#5) could both request Spanish. Thus, the system could output the languages to separate bins to prevent mix-ups of what users get what jobs.

Regarding claim 4, which depends from claim 3, the combination teaches **at least one output receptacle receives hardcopies of said document in a plurality of languages** (if User C and User E are of different languages [see Fig. 13 of Aihara], then bin 3 would receive a plurality of languages).

Regarding claim 10, which depends from claim 8, the structural elements of apparatus claim 3 perform all of the method steps of method claim 10. Method claim 10 is therefore rejected for the same reasons as stated in the rejection of apparatus claim 3.

Regarding claim 11, which depends from claim 10, the structural elements of apparatus claim 4 perform all of the method steps of method claim 11. Method claim 11 is therefore rejected for the same reasons as stated in the rejection of apparatus claim 4.

Regarding claim 17, which depends from claim 16, the structural elements of apparatus claim 3 perform all of the program functions of the printer driver program of claim 17. Further, a computer system such as 10 (Fig. 1) is known in the art to have a CPU and memory to execute instructions. Claim 17 is therefore rejected for the same reasons as stated in the rejection of apparatus claim 3.

Regarding claim 20, which depends from claim 18, the structural elements of apparatus claim 3 are the same or equivalent to the means of apparatus claim 20. Claim 20 is therefore rejected for the same reasons as stated in the rejection of claim 3.

6. Claims 6, 7, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong as applied to claims 1 and 8 above, and further in view of well known prior art.

Regarding claims 6 and 7, Chong teaches that the translation module 20 which acts as a translation program can reside in a separate translation processing system from the workstation computer 10 (col. 6 line 31), but Chong does not specifically say that this separate system is on a network or on the Internet.

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However, Examiner takes Official Notice that it is well known in the art that computer systems separate from other computer systems can be connected via a network (such as a LAN or WAN) and even the Internet.

It would have been obvious to one of ordinary skill in the art that a separate translation processing system could be connected to the workstation by a network or the Internet. The motivation for doing so would have been to allow multiple workstations like 10 access the translation module for use in translating a print job as well as workstations that are remote from the translation program to utilize it.

Regarding claims 13 and 14, which depend from claim 10, the structural elements of apparatus claims 6 and 7 perform all of the method steps of method claims 13 and 14. Method claims 13 and 14 are therefore rejected for the same reasons as stated in the rejection of apparatus claims 6 and 7.

Conclusion

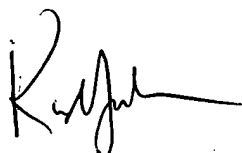
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2624



**KING Y. POON
PRIMARY EXAMINER**

ljd